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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,556	01/26/2001	Venkatesh Krishnan	10006129-1	6414
7590 05/20/2008 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80528-9599			EXAMINER LEE, PHILIP C	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 05/20/2008	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VENKATESH KRISHNAN, JEAN TOURRIHES, and
JEFFREY A. MORGAN

Appeal 2008-0403
Application 09/770,556
Technology Center 2100

Decided: May 20, 2008

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 18-34. Claims 1-17 have been cancelled (App. Br. 18). We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

THE INVENTION

The disclosed invention relates generally to the Internet and the World Wide Web. More particularly, Appellants' invention is directed to a key-chain tag-sized remote operator for an Internet appliance such that the Internet appliance can be remotely operated (Spec. 1).

Independent claim 30 is illustrative:

30. A method for wirelessly interacting with an Internet appliance comprising:

receiving a web address from a first Internet appliance;

storing said web address received from said first Internet appliance on said portable device, wherein said portable device is a key chain tag-sized device;

providing said web address to a second Internet appliance; and

organizing said portable device transfer of said web address to said second Internet appliance in a selected order.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Weiser	US 5,982,520	Nov. 9, 1999
Utsumi	US 6,243,741 B1	Jun. 5, 2001
Wiener	US 6,701,317 B1	Mar. 2, 2004

THE REJECTIONS

Claims 18, 24, and 30 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 18-22, 24-28, and 30-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weiser in view of Utsumi.

Claims 23, 29, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weiser in view of Utsumi, and further in view of Wiener.

ANALYSIS

Appellants contend that the new matter objection made by the Examiner under 35 U.S.C. § 132 is improper and should be withdrawn (App. Br. 9-10). This relates to a petitionable issue and not an appealable issue. *See In re Schneider*, 481 F.2d 1350, 1356-57 (CCPA 1973) and *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967). *See also* Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 6, Sept. 2007) § 1002.02(c), item 3(g) and § 1201. Thus, the relief sought by the Appellants would have been properly presented by a petition to the Commissioner under 37 C.F.R. § 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.

Enablement

35 U.S.C. § 112, first paragraph

We consider the issue of whether Appellants have shown that the Examiner erred in rejecting claims 18, 24, and 30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The issue turns upon whether the originally-filed Specification contains a teaching of the manner of making and using the claimed “preference control

for organizing said portable device transfer of said web address” without undue experimentation (claims 18 and 24). We note that the Examiner has withdrawn a first aspect of this rejection that was originally directed to a purported lack of enablement for the claimed “memory for storing said web address,” as recited in claims 18 and 24 (*see* Ans. 11, ¶1). Appellants have pointed to storage 43 (Fig. 3) and page 17 of the Specification (lines 9-20), as providing enabling support for the claimed memory element.

We begin our analysis by noting that independent claim 30 does not recite a “preference control.” Therefore, we *pro forma* reverse the Examiner’s rejection of claim 30 under 35 U.S.C. § 112, first paragraph. The question before us is whether Appellants’ Specification provides enabling support of the “preference control” recited in independent claims 18 and 24.

The first paragraph of 35 U.S.C. § 112 requires that the manner of making and using the claimed invention must be clearly set forth in the specification, as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same
(35 U.S.C. § 112, first paragraph).

The “enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citation omitted). Whether undue experimentation is required is a conclusion reached by weighing several underlying factual inquiries. *In re Wands*, 858 F.2d 731, 736 (Fed. Cir. 1988). A

“specification need not disclose what is well known in the art.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984). However, this “is merely a rule of supplementation, not a substitute for a basic enabling disclosure.” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. *Id.* It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. *Id.*

In the present case, Appellants point to the disclosed functions of the CUSTOMIZED 38, UP 31, and DOWN 32 buttons (shown in Figure 2) as providing enabling support for the claimed “preference control.” (*see* claims 18 and 24). We note that Appellants’ Specification discloses using the CUSTOMIZED 38 button to tag (i.e., bookmark) and store web addresses in either a general or customized storage area of storage 43 (*See* Spec. 19, ll. 2-17). Appellants’ Specification further discloses using the UP 31 and DOWN 32 buttons to move (i.e., reorder) web addresses previously stored in storage 43 to the top or bottom of storage 43 (Spec. 20, ll. 6-8) for sending (i.e., transmitting) to an external Internet application (Spec. 20, ll. 12 -14).

Although not providing literal support, we nevertheless find that the aforementioned control buttons provide sufficient teaching of the manner of making and using the claimed “preference control for organizing said portable device transfer of said web address,” as recited in each of independent claims 18 and 24. We agree that an artisan at the time of the invention would have reasonably associated the disclosed control buttons with the claimed preference control. Given such teaching, we conclude that

an artisan, having read the Specification, would have reasonably been able to practice the claimed invention without undue experimentation. Therefore, we reverse the Examiner's rejection of claims 18 and 24 under 35 U.S.C. § 112, first paragraph.

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Brief to show error in the proffered *prima facie* case.

Independent claims 18, 24, and 30

We consider the Examiner's rejection of independent claims 18, 24, and 30 as being unpatentable over Weiser in view of Utsumi. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we select independent

claim 30 as the representative claim for this rejection because we find it is the broadest claim before us. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Elements under 35 U.S.C. § 103

Appellants contend that the combination of Weiser and Utsumi does not teach the limitation of wirelessly receiving a web address, as required by the language of each independent claim (App. Br. 13-14).

We disagree. We note that Weiser discloses a wireless receiver 47 and a wireless transmitter 48 for receiving and sending wireless digital data:

As best seen with reference to the general electronic schematic of FIG. 2, the casing 38 (dotted line) of the personal storage device 30 externally supports a user accessible display 34, input buttons 32, and transceiver 46. The transceiver 46 includes a wireless receiver 47 and a wireless transmitter 48, for respectively receiving wireless transmissions 112 and sending wireless transmissions 110.
(Weiser, Col. 4, ll. 54-60).

The Examiner looks to the secondary Utsumi reference for the teaching of the *type* of digital data transmitted (i.e., a web address or URL) (Ans. 5).

After considering the evidence before us, it is our view that transmitting a web address or URL (as taught by Utsumi at column 7, lines 40-42) also reasonably suggests receiving a web address or URL. In particular, we note that digital data is transmitted for the purpose of being received.

Moreover, we find the data being received in representative claim 30 (i.e., web address data) constitutes “non-functional descriptive material” and is not accorded patentable weight. *Functional* descriptive material consists

of data structures or computer programs which impart functionality when employed as a computer component. *Non-functional* descriptive material refers to data content that does not exhibit a functional interrelationship with the substrate and does not affect the way the computing processes are performed. See MPEP § 2601.01. In a precedential decision, an expanded Board panel recently held that elements that do not affect the claimed process are non-functional material and are merely descriptive. See *Ex parte Nehls*, (BPAI 2008) (precedential) (Appeal No. 2007-1823).¹

The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). See also *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (*aff'd* 191 Fed. Appx. 959 (Fed. Cir. 2006)); Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d at 1339.

Regarding representative claim 30, we find that the recited step of “receiving” does not change its function according to the type of the data being received (i.e., a web address). Because the web address bears no functional relationship to the substrate (i.e., storage), we accord the type of data being received (i.e., web address data) no patentable weight as non-functional descriptive material. Indeed, our review of representative claim 30 merely finds steps recited for receiving, storing, providing, and organizing the transfer of the aforementioned web address data. In particular, we find claim 30 is silent regarding any use of the aforementioned

¹ See <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>

web address data to perform an *addressing function* so as to impart functionality to the claimed descriptive material. Thus, we conclude that the recited limitation of “web address” data does not provide any new and unobvious functions to the steps recited in representative claim 30. Based upon the foregoing reasoning, we conclude that Appellants have not met their burden of showing error in the Examiner’s findings of fact.

Combinability under 35 U.S.C. § 103

Regarding Appellants arguments against the combinability of the cited references (App. Br. 13-14), our reviewing court has reaffirmed that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739).

This reasoning is applicable here. The Examiner has combined familiar elements taught by the cited references, i.e., wireless Internet devices/appliances (*see* Weiser’s PDA 22 and laptop 23, Fig. 1), a key-chain portable wireless storage device (*see* Weiser’s personal storage device 30, as described in col. 4, ll. 17-24, Fig. 1), and the transmission of URL address data (*see* Utsumi, col. 7, ll. 36-52). We find the Examiner’s proffered combination of such familiar elements would have yielded predictable results. Appellants have not rebutted the Examiner’s legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

Accordingly, we find Appellants' arguments unpersuasive that the cited references have been improperly combined by the Examiner.

For at least the aforementioned reasons, we conclude that Appellants have not shown the Examiner erred in establishing *prima facie* obviousness in rejecting representative claim 30. Therefore, we sustain the Examiner's rejection of claim 30 (and independent claims 18 and 24 that fall therewith) as being unpatentable over Weiser in view of Utsumi. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent claims 19-23, 25-29, and 31-34

We note that dependent claims 19-23, 25-29, and 31-34 were not separately argued in the Brief. Therefore, we sustain the Examiner's rejection of claims 19-22, 25-28, and 31-33 as being unpatentable over Weiser in view of Utsumi for the same reasons discussed *supra* with respect to representative independent claims 18, 24, and 30, respectively. For the same reasons, we sustain the Examiner's rejection of dependent claims 23, 29, and 34 as being unpatentable over Weiser in view of Utsumi and Wiener. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 18-34 under 35 U.S.C. § 103(a) for obviousness.

However, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 18, 24, and 30 under 35 U.S.C. § 112, first paragraph.

DECISION

Because we have affirmed at least one rejection for each claim on appeal, we affirm the Examiner's decision rejecting claims 18-34.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80528-9599